

REMARKS/ARGUMENTS

In view of the remarks and arguments below, Applicant believes the pending application is in condition for allowance.

I. Status of the Claims

No claim amendment is made.

Claims 1-10 are pending and at issue. They are presented herein as a courtesy to the Examiner.

II. Withdrawal of Claim Rejections Issued in Non-Final Office Action of October 17, 2007

In response to the arguments Applicant presented in the Amendment filed on February 15, 2008, the Examiner states: "Applicant's arguments with respect to claims 1-10 have been considered but are moot in view of the new ground(s) of rejection."¹ Applicant respectfully understands this to mean that the claim rejections issued in the Non-Final Office Action dated October 17, 2007, have been withdrawn.

III. Rejections of Claims 1-3 and 6-10 under 35 U.S.C. § 103(a)

Claims 1-3 and 6-10 are rejected under 35 U.S.C. § 103(a) as unpatentable over United States Patent No. 6,221,978 to Li et al. ("Li") when taken with DYNACOLL® polyester data from Degussa® ("Degussa") and in view of Japanese Patent Application Publication No. 05-051573 to Takahashi et al. ("Takahashi"). The Examiner contends that Li taken with Degussa and in combination with Takahashi renders claims 1-3 and 6-10 obvious. Applicant respectfully traverses the rejections.

¹ Non-Final Office Action dated May 28, 2008, page 5, lines 9-10.

The Examiner acknowledges that “Li’s main polyol” falls short of teaching “claim 1’s aliphatic polyester polyol.”⁸

Takahashi, on the other hand, discloses a moisture-curable urethane hot-melt adhesive that contains a urethane prepolymer, which is prepared by reacting a diisocyanate and the following polyol components⁹:

- a crystalline aliphatic polyester diol; and
- an aromatic polyester diol.

Takahashi further discloses that “[t]he combined use of the crystalline aliphatic polyester diol and the arom[atic] polyester diol serve[s] to improve remarkably the initial adhesion” of the resulting moisture-curable hot-melt adhesive.¹⁰ (Degussa is relied upon solely for its disclosure of the molecular weight and glass transition temperature of “Li’s supplemental amorphous polyester polyol.”¹¹)

Based on these disclosures, the Examiner concludes that it would have been obvious to one of ordinary skill in the art to replace “Li’s main polyol” with Takahashi’s crystalline aliphatic polyester diol to arrive at the subject matter of claim 1.¹² According to the Examiner, this is because one would have been motivated to improve the adhesion of Li’s adhesive by the combined use of Takahashi’s crystalline aliphatic polyester diol and the already present aromatic polyester polyol in Li (namely, “Li’s supplemental amorphous polyester polyol”).¹³

However, Li already incorporates Takahashi’s teaching of a crystalline aliphatic polyester diol. Li already discloses that its polyol may also contain a crystalline aliphatic polyester polyol (namely, “Li’s supplemental crystalline aliphatic polyester polyol”). Therefore, given Li’s and

⁸ Non-Final Office Action dated May 28, 2008, page 2, lines 15 and 22.

⁹ The English-language abstract of Takahashi submitted with the Information Disclosure Statement filed on October 5, 2006.

¹⁰ *Id.*

¹¹ Non-Final Office Action dated May 28, 2008, page 2, lines 19-21.

¹² Non-Final Office Action dated May 28, 2008, page 3, lines 4-8.

¹³ *Id.*

At least for this reason, Li taken with Degussa and in view of Takahashi and further in view of Critchfield does not render either claim 4 or claim 5 obvious. Accordingly, Applicant respectfully requests that the rejections of claims 4 and 5 be withdrawn.

CONCLUSION

In view of the foregoing, it is believed that claims 1-10 are in immediate condition for allowance and it is respectfully requested that the application be reconsidered and that all pending claims be allowed and the case passed to issue.

If there are any other issues remaining which the Examiner believes could be resolved through a Supplemental Response or an Examiner's Amendment, the Examiner is respectfully requested to contact the undersigned at the telephone number indicated below.

Dated: August 27, 2008

Respectfully submitted,

By 

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